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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,536	04/09/2001	Shelton Louie	1205-007/JRD	8460
21034	7590	04/08/2005	EXAMINER	
IPSOLON LLP 805 SW BROADWAY, #2740 PORTLAND, OR 97205			ZEENDER, FLORIAN M	
			ART UNIT	PAPER NUMBER
			3627	
DATE MAILED: 04/08/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/829,536

Applicant(s)

LOUIE ET AL.

Examiner

F. Ryan Zeender

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-7 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg in view of Mccullough et al and Markman. Denenberg et al disclose a method for tracking prescription orders through a retail pharmacy having a plurality of spaced apart locations comprising the steps of receiving the prescription order at a first location (col. 9, lines 64 through col. 10, line 4); entering data into a computer system at a second location (16); tagging a carrier of the prescription order with a barcode (col. 6, lines 30-38); storing the filled prescription at one of a plurality of storage locations having a plurality of cubbies (14, 18, 20); automatically detecting the prescription order at one of the plurality of storage locations with a barcode reader (col. 8, lines 46-50); recording the location of the prescription order (col. 6, lines 39-47); and displaying the location on a computer display that is viewable by pharmacy workers (col. 13, lines 27-47).

Denenberg et al further disclose the steps of automatically collecting timing information, storing the timing information, compiling workflow information based on the timing information, and determining an estimated completion time (col. 16, lines 1-43).

**Denenberg et al still further teach that it was well known at the time of the invention to group a plurality of prescription orders together in a common carrier (i.e., See for example the bag Fig. 5B; and Col. 10, lines 54-67).**

Denenberg et al fail to teach a tag that is detachably secure to the prescription order **(common carrier)** or that is rigidly secured to the prescription **(common carrier)**.

However, detachable and rigidly secure tags are both common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a rigidly secured tag with the invention of Denenberg et al to ensure that the tags aren't mistakenly lost. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a detachable tag with the invention of Denenberg et al, so that the tags may be re-used.

Denenberg et al. also fail to disclose a tag reader for each cubby. However, Denenberg et al disclose a tag reader (50) for the entire station, and an additional sensor (23) for each cubby that detects when a prescription is placed in the cubby or moved away. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a tag reader in each cubby, to reduce the workload of the worker and reduce error.

Denenberg does not teach that the cubby tag readers are hand-held and manually operated. However, hand-held and manually operated tag readers are common in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ hand-held and manually operated tag readers so that employees can be sure that the tags have been properly read.

Denenberg does not teach that prescription orders are tagged with a tag having the same identifier, wherein the identifier is unique to the customer nor does Denenberg teach the step of displaying status of prescription orders on a customer display.

Art Unit: 3627

Mccullough et al teach a paging system, wherein a unique customer identifier is used to identify prescriptions (col. 6, lines 6-52). Mccullough et al further teach a customer display (108) that displays the unique customer code and notifies the customer of the order status (see col. 3, lines 31-38; and col. 6, line 53 through col. 7, line 25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Mccullough et al with the invention of Denenberg to help a customer retrieve his prescription as quickly as possible.

Denenberg does not teach the step of automatically and electronically bundling the orders from the customer together so as to allow them to be identified with the customer and **tagging the common carrier**. Markman teaches a method and apparatus for reforming grouped items that comprises the step of automatically and electronically bundling orders from a customer together to allow them to be identified with the customer (see, for example, col. 2, lines 52-67 and col. 6, line 65 through col. 7, line 8), **and further tagging a common carrier (i.e., "label"; the common carrier would be the bundled together clothes hanger(s) common at dry cleaners; See col. 7, lines 9-21)**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Markman with the invention of Denenberg to automatically and electronically bundle a customer's orders and **tag a common carrier** to allow them to be identified with the customer for customer convenience.

3. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg et al and Mccullough et al as applied to claim 5 above, and further in view

Art Unit: 3627

of Engellenner et al. Denenberg et al and Mccullough et al disclose all of the limitations of the claims except for an electromagnetic tag and tag reader. Engellenner discloses an electromagnetic tag and tag reader (see Fig. 1) for locating items. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the tag and tag reader of Engellenner with the combination of Denenberg et al and Mccullough et al, because the tag reader of Engellenner can interrogate a larger spatial region.

4. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg et al and Mccullough et al as applied to claim 19 above, and further in view of Yehuda. Denenberg et al and Mccullough et al disclose all of the limitation of the claim except for a display of estimated completion. Yehuda discloses a display (16) that shows an estimated time until completion (see col. 4, lines 44-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Yehuda with the combination of Denenberg et al and Mccullough et al to help the customer quickly complete his transaction.

### ***Response to Arguments***

Applicant's arguments filed 1/24/2005 have been fully considered but they are not persuasive. The Examiner has addressed the applicant's new limitations in the rejection above. With regards to the applicant's other arguments, the Office has considered the arguments, but has determined the rejections to be proper for the reasons given in the rejection(s) above.

Art Unit: 3627


### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Ryan Zeender whose telephone number is (703) 308-8351 until April 13, 2005 and (571) 272-6790 thereafter. The examiner can normally be reached on Monday-Friday, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

F. Zeender  
Primary Examiner, A.U. 3627  
April 4, 2005

  
F. RYAN ZEENDER  
PRIMARY EXAMINER 4/4/05